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Michael Roberts

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FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

SPISICH, MARK

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/692,916
Filing Date: October 24, 2003
Appellant(s): ROBERTS ET AL.

Celia H. Leber
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7 July 2008 appealing from the Office action mailed 26 December 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Notice of Appeal filed in each of Application Serial Nos. 10/991,911, 10/036,022 and 11/248,087.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. There were no amendments after final rejection.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. Note that the patent number to Muhler et al was a "typo" in the prior action and which is also mentioned in appellant's brief (the correct number is 3,613,143).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,334,646	CHEN	8-1994
4,288,883	DOLINSKY	9-1981
3,613,143	MUHLER et al	10-1971
JP 1-72128	ITO	5-1989

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 55,57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 1-72128 (hereinafter '128) in view of Dolinsky (USP 4,288,883) and Chen (USP 5,334,646). '128 discloses an oral brush comprising a handle (3) with a head portion (1) at an end thereof and which head portion includes a brush portion including a plurality of non-elastomeric (nylon) bristles as well as a plurality of elastomeric bristles (page 5, line 28 thru page 6, line 4 of the attached translation). The preferred (or at least one of the two) elastomer may be either polyester based or polystyrene based thermoplastic elastomers (see page 4 of the attached translation) or block copolymers. With regard to the "radiused terminal end" (claim 55, lines 6-7), the patent to Dolinsky discloses rubber massage members (22a) (column 1, lines 46-50) with rounded or radiused terminal ends (fig 4 and column 2, lines 26-27). It would have been obvious to one of ordinary

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skill to have rounded the ends of the bristles (both elastomeric as well as conventional) of '128 to reduce any damage to the user's gums. With regard to the particular material, the patent to Chen discloses the recited material (styrene-ethylene-butylene-styrene block copolymer, abstract, lines 1-4) along with a plasticizing oil which is further recognized by Chen as being used in a dental floss (column 7, lines 18-41). It is further pointed out that '128 discloses that the same engineering elastomer that is used to make up the elastomeric members on the oral brush may also be used as dental floss as well (in the translation, the last paragraph of page 4 as well as lines 9-13 of page 6). It would have thus been obvious to one of ordinary skill to have chosen the material of Chen to comprise the elastomeric members (eg, 12) of '128 in that (1) '128 discloses the genus of the recited material and (2) Chen discloses the recited material used in the same environment. It has further been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard to the hardness, the prior art is also used as an oral brush and that one of ordinary skill would deem it obvious to select material that would not harm the user's gums or teeth.

Claims 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 1-72128, Dolinsky (USP 4,288,883) and Chen (USP 5,334,646) as applied to claim 55 above, and further in view of Muhler et al (USP 3,613,143). The prior art discloses the invention substantially as claimed with the exception of the non-elastomeric (nylon) bristles including an abrasive. The patent to Muhler discloses an oral brush including plastic (nylon; column 3, line 26) including a dental abrasive

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(column 3, line 15) and having a diameter of 8 mil (column 8, line 44). It would have been obvious to one of ordinary skill to have modified the non-elastomeric (nylon) bristles of '128 as such to more effectively clean and polish tooth surfaces.

(10) Response to Argument

JP '128, as stated above, discloses an engineering elastomer material comprising elastomeric bristles on the head of an oral brush and further combined with non-elastomeric (nylon) bristles. Although '128 discloses the genus of the material presently recited in claim 55, it does not specify the specific material (styrene-ethylene-butylene-styrene block copolymer). The patent to Dolinsky is cited by the examiner solely for its teaching that the rubber/elastomeric elements may have rounded or "raduised" terminal ends (see element 22a in figure 4 of Dolinsky). The primary issue at hand in this application comes down to the particular material chosen for the elastomeric members. The recited material (styrene-ethylene-butylene-styrene) is a known material and which also is a species of the genus disclosed in JP '128. The patent to Chen was applied to show the recited material (with the addition of an oil plasticizer) and which elastomer may be used as dental floss (column 7, lines 18-41). This teaching it is believed is a common thread between Chen and JP '128, in that the elastomer disclosed in '128 (which is shown on the head of an oral brush) is also useful as dental floss as well. This at least provides a suggestion that the claimed material is known in the art as being useful in the oral environment. Appellant argues that the patent to Chen discloses "high levels if plasticizing oil" (abstract, lines 1-4 Of Chen). The problem is that appellant does not disclose (let alone claim) any level of oil which

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would be different than that in Chen. In fact, the only mention of the addition of an oil to the elastomer in the present applicant is on page 11 (lines 13-17). There is no mention of the quantity of oil nor is there any mention of any particular benefit of oil. The primary reference is used in the same environment and for the same general purpose as the presently claimed oral brush. The patent to Chen is mainly relied on for the disclosure of the material recited in claim 55 and also for its suggestion or teaching that this material may be used in a dental environment. With regard to the hardness, one of ordinary skill would be aware of hardness values which would be appropriate and comfortable for the intended use in a user's mouth and that the selection of a material(s) suitable for this purpose would be obvious to one of ordinary skill.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Mark Spisich/

Primary Examiner, Art Unit 3723

/M. S./

Conferees: /Joseph J. Hail, III/

SPE, Art Unit 3723

/Boyer D. Ashley/

SPE, Art Unit 3724